

05/14/01

1c961 U.S. PTO

05-15-01

PTO/SB/05 (11-00)

Please type a plus sign (+) inside this box ☐

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**UTILITY
PATENT APPLICATION
TRANSMITTAL**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

| | |
|------------------------|--|
| Attorney Docket No. | 30435.69USD4 |
| First Inventor | Robert E. Reiter |
| Title | PSCA: PROSTATE STEM CELL ANTIGEN AND USES THEREOF |
| Express Mail Label No. | ET614793791US |

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original and a duplicate for fee processing)
2. ☒ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 141]
(preferred arrangement set forth below)
 - Descriptive title of the invention
 - Cross Reference to Related Applications
 - Statement Regarding Fed sponsored R & D
 - Reference to sequence listing, a table, or a computer program listing appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings (if filed)
 - Detailed Description
 - Claim(s)
 - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 79]
5. Oath or Declaration [Total Pages 12]
 - a. ☐ Newly executed (original or copy)
 - b. ☒ Copy from a prior application (37 CFR 1.63 (d))
(for continuation/divisional with Box 18 completed)
 - i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☒ Application Data Sheet. See 37 CFR 1.76

ADDRESS TO:Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
 - a. ☐ Computer Readable Form (CRF)
 - b. Specification Sequence Listing on:
 - i. ☐ CD-ROM or CD-R (2 copies); or
 - ii. ☐ paper
 - c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement [Power of Attorney]
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 [Copies of IDS Citations]
13. ☐ Preliminary Amendment
14. ☐ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☐ Request and Certification under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent. Transmittal sheets
17. ☒ Other: return postcard

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

| | | | |
|--|--|---|---|
| <input type="checkbox"/> Continuation | <input checked="" type="checkbox"/> Divisional | <input type="checkbox"/> Continuation-in-part (CIP) | of prior application No.: <u>09 / 359,326</u> |
| Prior application information: Examiner <u>Larry Helms</u> | | | Group Art Unit: <u>1642</u> |

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS☒ Customer Number or Bar Code Label 26,941 or ☐ Correspondence address below
(Insert Customer No. or Attach bar code label here)

| | | | |
|---------|-----------|----------|--|
| Name | | | |
| | | | |
| Address | | | |
| | | | |
| City | State | Zip Code | |
| Country | Telephone | Fax | |

| | | | |
|-------------------|-------------------------|-----------------------------------|----------------|
| Name (Print/Type) | Sarah B. Adriano | Registration No. (Attorney/Agent) | 34,470 |
| Signature | <u>Sarah B. Adriano</u> | Date | <u>5/14/01</u> |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

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FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 490

Complete if Known

| | |
|----------------------|------------------|
| Application Number | Not yet known |
| Filing Date | May 14, 2001 |
| First Named Inventor | Robert E. Reiter |
| Examiner Name | Larry Helms |
| Group Art Unit | 1642 |
| Attorney Docket No. | 30435.69USD4 |

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 50-0306
Deposit Account Name: Mandel & Adriano

- ☐ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | Small Entity | Fee Code (\$) | Fee Code (\$) | Fee Description | Fee Paid |
|--------------|--------------|---------------|---------------|------------------------|----------|
| 101 | 710 | 201 | 355 | Utility filing fee | 355 |
| 106 | 320 | 206 | 160 | Design filing fee | |
| 107 | 490 | 207 | 245 | Plant filing fee | |
| 108 | 710 | 208 | 355 | Reissue filing fee | |
| 114 | 150 | 214 | 75 | Provisional filing fee | |

SUBTOTAL (1) (\$) 355

2. EXTRA CLAIM FEES

Total Claims: 35
Independent Claims: 2
Multiple Dependent: 33
Extra Claims: 14
Fee from below: 9
Fee Paid: 135

| Large Entity | Small Entity | Fee Code (\$) | Fee Code (\$) | Fee Description |
|--------------|--------------|---------------|---------------|--|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 80 | 202 | 40 | Independent claims in excess of 3 |
| 104 | 270 | 204 | 135 | Multiple dependent claim, if not paid |
| 109 | 80 | 209 | 40 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$) 135

*or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity | Small Entity | Fee Code (\$) | Fee Code (\$) | Fee Description | Fee Paid |
|--------------|--------------|---------------|---------------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for ex parte reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 390 | 216 | 195 | Extension for reply within second month | |
| 117 | 890 | 217 | 445 | Extension for reply within third month | |
| 118 | 1,390 | 218 | 695 | Extension for reply within fourth month | |
| 128 | 1,890 | 228 | 945 | Extension for reply within fifth month | |
| 119 | 310 | 219 | 155 | Notice of Appeal | |
| 120 | 310 | 220 | 155 | Filing a brief in support of an appeal | |
| 121 | 270 | 221 | 135 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,240 | 241 | 620 | Petition to revive - unintentional | |
| 142 | 1,240 | 242 | 620 | Utility issue fee (or reissue) | |
| 143 | 440 | 243 | 220 | Design issue fee | |
| 144 | 600 | 244 | 300 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 710 | 246 | 355 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 149 | 710 | 249 | 355 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 179 | 710 | 279 | 355 | Request for Continued Examination (RCE) | |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

SUBMITTED BY

| | | | | | |
|-------------------|------------------|-----------------------------------|---------|-----------|--------------|
| Name (Print/Type) | Sarah B. Adriano | Registration No. (Attorney/Agent) | 34,470 | Telephone | 626-395-7801 |
| Signature | Sarah B. Adriano | Date | 5/14/01 | | |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| DOCKET NUMBER | ANTICIPATED CLASSIFICATION OF THIS APPLICATION: | | PRIOR APPLICATION | |
|---------------|---|----------|-------------------|----------|
| | CLASS | SUBCLASS | EXAMINER | ART UNIT |
| 30435.54USD4 | Unknown | Unknown | L. Helms | 1642 |

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: ET614793791US
Date of Deposit: May 14, 2001

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By: 

Name: Tracy Truick

DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

This is a request for filing a divisional application under 37 CFR § 1.53(b) of Serial No. 09/359,326, filed on May 3, 2000 entitled PSCA: PROSTATE STEM CELL ANTIGEN AND USES THEREOF by the following inventor(s):

| | | | |
|-------------------------|---|--|--|
| Full Name Of Inventor | Family Name Reiter | First Given Name Robert | Second Given Name E. |
| Residence & Citizenship | City Los Angeles | State or Foreign Country California | Country of Citizenship US |
| Post Office Address | Post Office Address 10511 Kinnard Avenue | City Los Angeles | State & Zip Code/Country California 90024/USA |
| Full Name Of Inventor | Family Name Witte | First Given Name Owen | Second Given Name N. |
| Residence & Citizenship | City Sherman Oaks | State or Foreign Country California | Country of Citizenship US |
| Post Office Address | Post Office Address 14727 Sutton Street | City Sherman Oaks | State & Zip Code/Country California 91403/USA |
| Full Name Of Inventor | Family Name Saffran | First Given Name Douglas | Second Given Name C. |
| Residence & Citizenship | City Los Angeles | State or Foreign Country California | Country of Citizenship Canada |
| Post Office Address | Post Office Address 11720 Bellagio Road #204 | City Los Angeles | State & Zip Code/Country California 90049/USA |
| Full Name Of Inventor | Family Name Jakobovits | First Given Name Aya | Second Given Name |
| Residence & Citizenship | City Beverly Hills | State or Foreign Country California | Country of Citizenship US |
| Post Office Address | Post Office Address 3135 Hutton Drive | City Beverly Hills | State & Zip Code/Country California 90201/USA |

1. ☒ Enclosed is a true and correct copy of the prior application; including the specification, claims, drawings, oath or declaration showing the applicant's signature, and any amendments referred to in the oath or declaration filed to complete the prior application. (It is noted that no amendments referred to in the oath or declaration filed to

complete the prior application introduced new matter therein.) The copy of the prior application is as follows: 141 pages of specification, 305 claims, 1 pages of abstract, 79 sheets of drawings, and 12 pages of oath or declaration.

2. ☒ Cancel in this application original claims 1-52 of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
3. ☒ The filing fee is calculated below:

CLAIMS AS FILED

| NUMBER FILED | NUMBER EXTRA | | RATE | FEE |
|-----------------------------------|--------------|---|--------------------------|----------|
| TOTAL CLAIMS: 35 -20 | 15 | x | \$9.00 | \$135.00 |
| INDEPENDENT CLAIMS 2 -3 | 0 | x | \$40.00 | \$0.00 |
| | | | BASIC FILING FEE: | \$355.00 |
| | | | TOTAL FILING FEE: | \$490.00 |
| | | | | |

☐ A Verified Statement that this filing is by a small entity is already filed in the prior application.

☐ A Verified Statement that this filing is by a small entity is attached.

☒ Payment of fees:

☒ Attached is a check in the amount of \$490.00.

☐ Please charge Deposit Account No. 50-0306.

☒ The Commissioner is hereby authorized to charge any additional fees as set forth in 37 CFR §§ 1.16 to 1.18 which may be required by this paper or credit any overpayment to Account No. 50-0306.

6. ☒ Amend the specification by inserting before the first line the sentence:

"This is a Divisional of application Serial No. 09/564,329, filed May 3, 2000, which is a continuation-in-part application of U.S. Serial No. 09/359,326, filed July 20, 1999, which was a continuation-in-part of U.S. Serial No. 09/318,503, filed May 25, 1999, which was a continuation-in-part of U.S. Serial No. 09/251,835, filed February 17, 1999, which was a continuation-in-part of U.S. Serial No. 09/203,939, filed December 2, 1998, which was a continuation-in-part of U.S. Serial No. 09/038,261, filed March 10, 1998, which is claiming priorities of 60/124,658, filed March 16, 1999, which is claiming priority of 60/120,536, filed February 17, 1999, which is claiming priority of 60/113,230, filed December 21, 1998, which is claiming priority of 60/074,675, filed February 13, 1998, which is claiming priority of 60/071,141, filed January 12, 1998, which is claiming priority of 60/228,816, filed March 10, 1997 which application(s) are incorporated herein by reference."

7. ☐ A set of formal drawings (____ sheets) is enclosed.

8. ☐ Priority of application Serial No. _____, filed on _____ in _____, is claimed under 35 U.S.C. 119.

☐ The certified copy has been filed in prior application Serial No. _____, filed _____.

9. ☒ The prior application is assigned of record to The Regents of the University of California.

10. ☒ The Power of Attorney in the prior application is to:

Mandel & Adriano
35 N. Arroyo Parkway, Suite 60
Pasadena, California 91103

11. ☒ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

☐ Fee for excess claims is attached.

12. ☐ A petition and fee has been filed to extend the term in the prior application until _____. A copy of the petition for extension of time in the prior application is attached.

13. ☐ The inventor(s) in this application are less than those named in the prior application and it is requested that the following inventors identified above for the prior application be deleted:

☐ Also Enclosed:

☒ Address all future communications to the **Attention of Sarah B. Adriano** (may only be completed by attorney or agent of record) at the address below.

☒ A return postcard is enclosed.

Respectfully submitted,

Sarah B. Adriano

Sarah B. Adriano
Reg. No. 34,470
Attorney for Applicants
Mandel & Adriano
35 No. Arroyo Parkway, Suite 60
Pasadena, California 91103
626/395-7801
Customer No. 26,941